

USSN: 09/828,638
Atty. Docket No.: 2001B025
Amdt. dated December 18, 2003
Reply to final Action of September 2, 2003

REMARKS/ARGUMENTS

Upon entry of the claim amendments, Claims 1-23 will be all the claims pending in the application.

Claims 1 and 15 have been amended to clarify that the printable coating composition comprises (a) an anionic acrylic polymer, (b) an epoxy acrylate, and (c) a cross-linking agent.

New Claims 21-23 are supported by the description at page 4, lines 12-27, as well as original Claims 3, 4, and 12. Regarding the film-forming thermoplastic material, terephthalates, such as the polyethylene terephthalate and polybutylene terephthalate described at page 4, are thermoplastic polyesters encompassed by the scope of new Claims 21 and 23.

No new matter has been added.

As per the final Action mailed September 2, 2003, the claims stand rejected as follows:

Claims 1-5, 9-11, 15-18 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,662,985 to Jensen, *et al.* ("Jensen") in view of U.S. Patent No. 5,804,301 to Curatolo and U.S. Patent No. 6,406,775 to Houde;

Claims 1-2, 6-8, 15-18, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jensen in view of Curatolo and U.S. Patent No. 5,883,193 to Karim; and

Claims 1-2, 12-14, 15-16, and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jensen over Houde and U.S. Patent No. 6,225,389 to Saint Victor

Applicant respectfully traverses each of the rejections for the reasons presented in the Response filed November 3, 2003. That is, the present specification contains objective evidence of patentability, which, by at least a preponderance of the evidence, serves to rebut any alleged

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case of obviousness against the claims of the application. In particular, a printable coating composition comprising the claimed combination of (i) an anionic acrylic polymer, (ii) an epoxy acrylate, and (iii) a cross-linking agent provides a synergistic effect. For a more detailed explanation of Applicant's position in this regard, Applicant kindly invites the Examiner to review the remarks filed November 3, 2003.

In the Advisory Action mailed November 17, 2003, the Examiner indicated that the Response filed November 3rd did not place the application in condition for allowance. First, the Examiner asserted that the claimed invention is not commensurate in scope with the experimental data provided in the specification. Second, the Examiner asserted that there is no evidence to show that the results obtained in Examples 5-9 extend to the full scope of Applicant's claimed invention.

In response, Applicant respectfully points out that independent Claims 1, 15 and 20 have been amended to clarify that the printable coating composition comprises (a) an anionic acrylic polymer, (b) an epoxy acrylate, and (c) a cross-linking agent. Accordingly, the claimed invention is commensurate in scope with the experimental data provided in the specification.

Furthermore, evidence of nonobviousness may consist of a comparison between the prior art and just a single composition representative of the broader scope of the claims, so long as the single composition is representative such that an adequate basis exists for reasonably concluding that the full scope of the invention recited in the claims would behave in the same manner as the tested composition.

Applicant notes that when evaluating the presence of an adequate basis for reaching a reasonable conclusion, the standard to be applied is the "preponderance of the evidence" standard. The "preponderance of the evidence" standard is a relatively low threshold; it is lower than "clear and convincing" and much lower than "beyond a reasonable doubt." By a "preponderance of the evidence" merely requires that the facts be more likely in Applicant's favor than not.

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Applicant respectfully submits that the experimental data presented in the specification permits one of ordinary skill in the art to reasonably extend the probative value of the experimental data to the full scope of the inventions recited in Claims 1, 15 and 20. However, should the Examiner not be persuaded in this regard, Applicant kindly invites the Examiner to evaluate the patentability of dependent Claims 3-6, 12-13, 17-19, and 21-23, which are directed to narrower embodiments of the present invention.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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